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10/759,100

01/20/2004

Shigeru Tago

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6941

7590

12/06/2006

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EXAMINER

VY, HUNG T

ART UNIT

PAPER NUMBER

2163

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/759,100

Applicant(s)

TAGO, SHIGERU

Examiner

Hung T. Vy

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,6-10,13-16 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-10,13-16 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/26/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. As of entry of the amendment filed on dated 09/26/2006, claims 1-4, 6-10, 13-16 and 19-21 are pending in this application as result of the cancellation of the claims 11-12 and 17-18 and the additional of the claims 20-21. Upon reconsideration, the rejection of claims 1-4, 6-10, 13-16 and 19-21 by Minch et al. mailed 6/29/2006 is hereby withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Minch and AU.

### **Acknowledges**

2. Receipt is acknowledged of the following items from the Applicant.

Information Disclosure Statement (IDS) filed on 09/25/2006. The references cited on the PTOL 1449 form have been considered.

### **Claim Rejections - 35 USC § 112**

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 10 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: entering a starting search key. The invention shows that the interface that let the user selects the start database and destination database. The figure (database) contains records with search key so the user cannot enter the search key that is already in the database. Further the applicant should also include the step reciting of where or how to enter a starting search key. The drawing only shows the figured representing the database and "OK" button, but no figures show "the search keys" and "entering a starting search key".

Claims 2-4 and 7-19 depend from rejected claims 1 and 6 thereby render these dependent claims indefinite

**Claim Rejections - 35 USC 101**

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

With respect to claim 9, the claim is rejected under 35 U.S.C. 101 because the claim does not specify that the computer program product be embodied on a computer readable medium. A computer program product that is not embodied on an acceptable computer readable medium is nothing more than an abstract idea. When the computer program product is recorded on an acceptable computer readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the computer program product to be realized. Appropriate correction is required.

**Claim Rejections - 35 USC § 102**

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1 and 6 are rejected under 35 U. S. C. § 102 (e) as being anticipated by Minch et al. (U.S. Pub. No. 2004/0049510).

With respect to claims 1, and 6, as best understood, Minch et al. discloses a method of designating a database search path and a program for causing a computer to carry out a method of designating a database search path comprising steps of: the method comprising: a first step of automatically displaying databases that can be search targets (see fig. 2 or fig. 4), in the form of figures on a screen, each of the databases containing records with search keys of related records stored in other databases; a second step of designating two figures of databases as a starting database and a terminal database respectively (See paragraph 0008 or 0033, 0058); a third step of automatically carrying out a chain-reactive retrieval of search keys and records (see paragraph 0009) by entering a starting search key by an user into the starting database to retrieve a record therefrom (see paragraph 0058) and automatically retrieving a next search key which is different from the starting search key and contained in said retrieved record (see column 0095)(i.e. "a simple bottom press, the system no initiates further queries in the database on reaction pathway"), and automatically entering the next search key into a next database to retrieve a next record therefrom in a chain reactive manner (i.e. "on reaction pathway") from the starting database via a plurality of intervening databases to the terminal database (see paragraph 0095-0102); and a fourth step of automatically linking (see paragraph 0103 and fig. 4), and displaying

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the starting database, the intervening databases, and the terminal database linked as search path candidates (see paragraph 0104 and figs. 2-4).

4. Claims 1 and 6 are rejected under 35 U. S. C. § 102 (e) as being anticipated by Niwa et al. (U.S. Patent.5, 987, 460).

With respect to claims 1, and 6, as best understood, Niwa et al. discloses a method of designating a database search path and a program for causing a computer to carry out a method of designating a database search path comprising steps of: the method comprising: a first step of automatically displaying databases that can be search targets (see fig. 8), in the form of figures on a screen, each of the databases containing records with search keys of related records stored in other databases; a second step of designating two figures of databases as a starting database (i.e. "*coordinate of start point*") and a terminal database (i.e. "*coordinate of end point*") respectively (See fig. 7); a third step of automatically carrying out a chain-reactive retrieval of search keys and records (see fig. 8) by entering a starting search key by an user into the starting database to retrieve a record therefrom (see fig. 8) and automatically retrieving a next search key which is different from the starting search key and contained in said retrieved record (see column) , and automatically entering the next search key into a next database to retrieve a next record therefrom in a chain reactive manner (i.e. "publishing → mail → nifty serve ") (see fig. 8) from the starting database via a plurality of intervening databases to the terminal database (i.e. "*mail*") (see fig 8); and a fourth step of automatically linking (see fig. 8), and displaying the starting database, the intervening databases, and the terminal database linked as search path candidates (see fig. 8).

**Claim Rejections - 35 U.S.C. § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 7-10, 13-16, and 19-21 are rejected under 35 U.S.C. 103 (a) as being unpatentable over U.S. Minch et al. (U.S. Patent. No. 2004/0049510) in view of AU (U.S. Pub. 2003/0191627).

With respect to claims 2, and 7, Minch et al. discloses all limitations of claimed recited in claim 1 invention except for display in highlight a database search path selected among the search path candidates. However, US discloses display in highlight a database search path selected among the search path candidates (see fig. 29 and paragraph 0104, 0249). It would have been obvious to one of ordinary skill in art to the time the invention was made to implement the system of Minch et al. by adding the function as display in highlight a database search path selected among the search path candidates in order to improves the meaning of paths identified and easy visible for user interface since such highlight a database search path selected among the search path candidates for the state purpose has been well known in the art as evidenced by teach of AU (see paragraph 0306).

With respect to claims 3-4, and 8-9, Minch et al. discloses the third step selecting the database search path by designating an intervening database (i.e. "*brevibacterium sterolicum*") to be including therein such that the database search path passes through said designated

intervening database the starting database (i.e. "*Aeromonas hydrophila*") and the terminal database (i.e. "*Cricetulus griseus*") (see paragraph 0103).

With respect to claims 10, 13-16, and 19-21, Au discloses at least one of a module of displaying, upon designation of the starting search key, only database that can be searched with the starting, search key in highlight as the starting database candidates, on the screen distinguishing from other dataset a module of display upon designation of the starting database (i.e. "*food #1*"), only next database that contains a next search key (i.e. "*food #2*") and a next record in highlight to be designated as the terminal database (i.e. "*satisfaction #2*") on screen distinguishing from other databases (see fig. 29-30).

### Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung T. Vy whose telephone number is 571-2721954. The examiner can normally be reached on 8.30am - 5.30 pm.

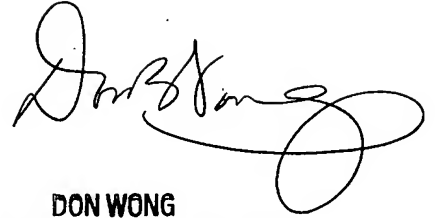
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571 272 1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hung T. Vy  
Art Unit 2163  
November 29, 2006.

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A handwritten signature in black ink, appearing to read 'Don Wong', with a large, stylized loop at the end.

**DON WONG**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**